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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,458	07/18/2000	Eiji Hayashi	862.C1958	8847

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FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
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CHAU, MINH H

ART UNIT	PAPER NUMBER
2854	17

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/618,458	HAYASHI, EIJI
Examiner	Art Unit	
Minh H Chau	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 March 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 27,28,30,32,33,35,36,38,40,41 and 43-56 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 27,28,30,32,33,35,36,38,40,41 and 43-56 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .                    6) Other: \_\_\_\_\_ .

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 27-28, 30, 32-33, 35-36, 38, 40-41, 43-46 and 49-50** are rejected under 35 U.S.C. 103(a) as being unpatentable over Streefkerk et al. (US # 6,104,470) in view of Ohtani (US # 6,144,818).

**With respect to claims 27, 35, 43 and 44,** Streefkerk et al. teach a printing system or an information processing system and a method for controlling a printer which comprises a printer controller (107) capable of controlling communication with at least one printer comprising printer list acquisition means for acquiring a printer list, printer selection means for selecting a printer from the printer list in accordance with a user's instruction, acquisition means for acquiring paper information on a printing paper set in the printer selected by the printer selection means (see cols. 2-4 of Streefkerk et al.).

Streefkerk et al. teach all the limitation except for the limitation means for limiting the staplable position on the basis of the paper information acquired by the acquisition means.

Ohanti teaches an image forming apparatus including a limitation means for limiting the staplable position on the basis of the paper information (see Figs. 6-9 and cols. 3-4 of Ohtani).

In view of this teaching, it would have been obvious to one of ordinary skill in the art to modify the device of Streefkerk et al. with the limitation means for limiting the staplable position on the basis of the paper information as taught by Ohtani for the advantage of allowing the correct stapling position according to the paper information can be achieve without any error.

**With respect to claims 28 and 36,** Streefkerk et al. teach all the limitation as explained above except for the “size setting means for setting information relating to a size of a printing paper” and the “limitation means further limits the staplable position on the basis of the information set by the size setting means”.

Ohanti teaches an image forming apparatus including a size setting means for setting information relating to a size of a printing paper and the limitation means for limits the staplable position on the basis of the information set by the size setting means (see cols. 3-5 of Ohtani).

In view of this teaching, it would have been obvious to one of ordinary skill in the art to modify the device of Streefkerk et al. to include the size setting means for setting a size of a printing paper and the limitation means for limits the staplable position based on the information set by the size setting means as taught by Ohtani so that to allow the correct stapling position on a specific paper size can be achieve without any error.

**With respect to claims 30 and 38,** Streefkerk et al. teach all the limitation as explained above except for the display means for displaying of a staplable position and an unstaplable position in an identifiable screen.

Ohanti teaches an image forming apparatus including display means for displaying of a staplable position and an unstaplable position in the screen of the host computer (see Figs. 6-9).

In view of this teaching, it would have been obvious to one of ordinary skill in the art to modify the device of Streefkerk et al. to include display means for displaying of a staplable position and an unstaplable position in the screen as taught by Ohtani so that the user can select a proper stapling position for a specific paper without any difficult.

**With respect to claims 32 and 40,** Streefkerk et al. teach all the limitation as explained above except for the limitation means limits a staplable position based on the paper information relating to the printing paper list stacked on the paper feed tray equipped in the printer selected by a user.

Ohtani teaches an image forming apparatus including limitation means limits a staplable position based on the paper information relating to the printing paper list stacked on the paper feed tray equipped in the printer selected by a user (see Fig. 5-9 and cols. 4-5 of Ohtani).

In view of this teaching, it would have been obvious to one of ordinary skill in the art to modify the device of Streefkerk et al. with the limitation means limits a staplable position based on the paper information relating to the printing paper list stacked on the paper feed tray equipped in the printer so that the user can easily select the staplable position for a specific printing paper stacked on the paper feed tray.

**With respect to claims 33 and 41,** Streefkerk et al. teach all the limitation as explained above except for the paper information includes R/non-R information to the printing paper.

Ohtani teaches an image forming apparatus including the paper information relates to the size of the printing paper and the feeding direction or the R/non-R information of the printing paper (see cols. 2-3 of Ohtani).

In view of this teaching, it would have been obvious to one of ordinary skill in the art to modify the device of Streefkerk et al. to include the paper information includes the R/non-R information relating to the printing paper that taught by Ohtani so that correct binding location of the printing paper can be determine.

**With respect to claims 45, 46, 49 and 50,** Streefkerk et al. teach all the limitation as explained above except for the location setting means for setting binding location and the limitation means limits the staplable position on the basis of the paper information, the information set by the size setting means and the binding location set the location setting means.

Ohtani teaches an image forming apparatus including first setting means or a size setting means for setting information relating to a size of a printing paper, second setting means or a location setting means for setting a binding location of the printing paper and the limitation means for limits the staplable position on the basis of the paper information, the information set by the size setting means and the binding location set by the locations setting means (see Figs. 5-10 and cols. 3-4 of Ohtani).

In view of this teaching, it would have been obvious to one of ordinary skill in the art to modify the device of Streefkerk et al. to include the first setting means or a size setting means for setting information relating to a size of a printing paper, second setting means or a location setting means for setting a binding location of the printing paper and the limitation means for limits the staplable position on the basis of the paper information, the information set by the size setting means and the binding location set by the locations setting means that taught by Ohtani so that the user can select a proper staplable position for a specific size of the paper without any difficult.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 47, 48 and 51-56** are rejected under 35 U.S.C. 102(e) as being anticipated by Ohtani (US # 6,144,818).

**With respect to claims 47, 51, 53 and 54,** Ohtani teaches an image forming apparatus or an information processing apparatus and a method of controlling a printer which comprises a printer controller capable of controlling communication with a printer (1) comprising first setting means for setting information relating to a size of a printing paper, second setting means for setting a binding location of the printing paper, limitation means for limiting further the binding location based on the information set by the first setting means and the binding location set by the second setting means and sending means for sending the binding position information the printer (see cols. 3-4 and Figs 5-10).

**With respect to claims 48, 52, 55 and 56**, Ohtani teaches an image forming apparatus or an information processing apparatus and a method of controlling a printer (1) having a stapling function (col. 2, line 48 of Ohtani) for binding together a plurality of sheets of printing paper that have been printed out at one of a plurality staplable positions (Fig. 5) and a plurality of paper feed trays (5) (col. 2, lines 41-42), comprising selection means for selecting a particular paper tray (5) from a plurality of paper feed trays (5), a limitation means for limiting, on the basis of the paper feed tray selected by the selection means, a usable staplable position from among the plurality of staplable positions (col. 5, lines 10-35), first setting means for setting a size of a printing paper, second setting means for setting a binding location and the limitation means limits the staplable position on the basis of the size of the printing paper set by the first setting means, the paper feed tray selected by the selection means and the binding location set the second setting means (see Figs. 1-9 and cols. 2-5 of Ohtani).

***Response to Arguments***

6. Applicant's arguments with respect to claims 27, 35, 43, 44, 47, 48 and 51-56 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh H Chau whose telephone number is (703) 305-0298. The examiner can normally be reached on M - TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MHC  
May 16, 2003



ANDREW H. HIRSHFELD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800